

A-27-09

JFW

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Docket No.: P/54265

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

I hereby certify that this correspondence is being deposited with the United States Postal Service as express mail No. EV667152667US in an envelope addressed to: MS: Petitions, Commissioner for Patents; P. O. Box 1450; Alexandria, VA 22313-1450, on:

January 26, 2009
(date)

Lori G. Wilkin

In re: Application of : Mark T. JEFFREY, et al.

Serial No. : 08/872,078 Group Art Unit: 2619

Filed : June 10, 1997 Examiner: J. Pezzlo

For : STM SWITCHING ARRANGEMENT

New York, New York
January 26, 2009

RENEWED PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 C.F.R. §1.181

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Decision on Petition dated November 25, 2008, additional information regarding the period from the filing of the subject application on June 10, 1997 to the filing of the subject petition on October 3, 2008 is hereby provided.

The undersigned, being duly sworn, states that no Notice of Allowance or Notice of Abandonment were ever received by the undersigned or his firm, and hereby petitions that the abandonment be withdrawn and the referenced application be revived based on the following facts and circumstances.

1. A Notice of Abandonment (*Exhibit 1*) was mailed by the PTO on July 8, 1997.

On July 14, 1997, the undersigned filed a request to withdraw said abandonment (*Exhibit 2*). That petition was granted by a decision (*Exhibit 3*) mailed February 10, 1998.

2. On May 20, 1998, the undersigned filed a change of attorney's address (*Exhibit 4*). Having received no response, the undersigned telephoned Examiner Kizou on September 18, 1998, but that call was not returned.

3. The undersigned eventually learned that Examiner Luther had taken over responsibility for this case upon receipt of a Notice of Abandonment for the parent case (*Exhibit 5*), which was mailed by Examiner Luther on December 9, 1998.

4. Having received no response, the undersigned telephoned Examiner Luther on July 15, 1999 and September 1, 2000, but those calls were never returned. The undersigned mailed a communication (*Exhibit 6*) on the merits to Examiner Luther on September 5, 2000, which was stamped as received by the PTO on September 15, 2000.

5. Having received no response, the undersigned repeatedly telephoned and left messages for Examiner Luther on June 6, 2001, April 8, 2002, November 6, 2002, August 4, 2003, February 9, 2004, May 6, 2005, but those calls were never returned. See telephone log (*Exhibit 7*).

6. The undersigned then repeatedly telephoned and left messages for Director Jin F. Ng of Technology Center 2700, on February 13, 2006 and December 12, 2007, but those calls were never returned. See telephone log (*Exhibit 7*).

7. The undersigned then telephoned Examiner Powell of Technology Center 2600 in June 2008, who in turn referred the undersigned to Examiner J. Patel, who in turn referred the undersigned to Examiner Pezzlo. Examiner Pezzlo eventually retrieved the file wrapper of the referenced application from storage in August 2008.

8. On August 7, 2008, Examiner Pezzlo advised the undersigned that the file wrapper revealed that a Notice of Allowance was mailed on August 13, 2001 *to the wrong attorney and to the wrong address*. As acknowledged, that Notice of Allowance was addressed to “James Dean Johnson, Jones and Askew, 191 Peachtree Street N.E., 37th Floor, Atlanta, Georgia 30303-1769”.

9. On August 7, 2008, Examiner Pezzlo also advised the undersigned that a Notice of Abandonment was mailed on May 6, 2002 *to a different wrong attorney and to a different wrong address*. As acknowledged, that Notice was addressed to “John S. Pratt, Esq., Kilpatrick Stockton LLP, 1100 Peachtree Street, N.E., Suite 2800, Atlanta, Georgia 30309”.

10. Examiner Pezzlo advised the undersigned that he would issue an Interview Summary confirming the above. Examiner Pezzlo suggested that the undersigned file a Change of Correspondence Address so that future correspondence be correctly directed by the PTO to the correct attorney and address of record. The undersigned complied on August 7, 2008.

11. Having not received the Interview Summary, the undersigned telephoned Examiner Pezzlo on October 1, 2008. He advised that the Interview Summary had erroneously not been mailed to the undersigned, but that he would send the undersigned a copy. On October 3, 2008, this petition was filed. Examiner Pezzlo actually mailed the Interview Summary on October 9, 2008, and it was received by the undersigned on October 14, 2008.

Under the circumstances, no Petition Fee is believed to be necessary under Rule 1.181. Clearly, applicants should not be penalized because the PTO sent correspondence to the wrong address, more than once. If, however, a petition fee is deemed appropriate, then the Commissioner is authorized to charge such fee to Deposit Account 11-1145.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

KIRSCHSTEIN, ISRAEL, SCHIFFMILLER & PIERONI, P.C.
Attorneys for Applicant(s)
425 Fifth Avenue, 5th Floor
New York, New York 10016-2223
Tel: (212) 697-3750
Fax: (212) 949-1690



Alan Israel
Reg. No. 27,564

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/400,140	03/06/95	JEFFREY	M GPT/4265-US

KIRSCHSTEIN OTTINGER
ISRAEL & SCHIFFMILLER
551 FIFTH AVENUE
NEW YORK NY 10176-0024

26M1/0708

EXAMINER

KIZOU, H

ART UNIT	PAPER NUMBER
2603	15

DATE MAILED: 07/08/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Notice of Abandonment

Application No. 08/400,140	Applicant(s) Jeffrey et al.
Examiner Hassan Kizou	Group Art Unit 2603

This application is abandoned in view of:

- applicant's failure to timely file a proper response to the Office letter mailed on Dec 9, 1996.
- A response (with a Certificate of Mailing or Transmission of _____) was received on _____, which is after the expiration of the period for response (including a total extension of time of _____ month(s)) which expired on _____.
- A proposed response was received on _____, but it does not constitute a proper response to the final rejection.
(A proper response to a final rejection consists only of: a timely filed amendment which places the application in condition for allowance; a Notice of Appeal; or the filing of a continuing application under 37 CFR 1.62 (FWC)).
- No response has been received.
- applicant's failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance.
- The issue fee (with a Certificate of Mailing or Transmission of _____) was received on _____.
- The submitted issue fee of \$ _____ is insufficient. The issue fee required by 37 CFR 1.18 is \$ _____.
- The issue fee has not been received.
- applicant's failure to timely file new formal drawings as required in the Notice of Allowability.
- Proposed new formal drawings (with a Certificate of Mailing or Transmission of _____) were received on _____.
- The proposed new formal drawings filed _____ are not acceptable.
- No proposed new formal drawings have been received.
- the express abandonment under 37 CFR 1.62(g) in favor of the FWC application filed on _____.
- the letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
- the letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
- the decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
- the reason(s) below:



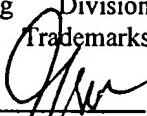
HASSAN KIZOU
PRIMARY EXAMINER
ART UNIT 2603

**PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box: Special Processing and Correspondence Branch, ONAR, Application Processing Division, Commissioner of Patents and Trademarks, Washington, D.C. 20231, on:

July 14, 1997

(date)



Alan Israel
Reg. No. 27,564

In re: Application of : Mark T. JEFFREY, et al.
Serial No. : 08/400,140 Group Art Unit: 2603
Filed : March 6, 1995 Examiner: H. Kizou
For : STM SWITCHING ARRANGEMENT

New York, New York
July 14, 1997

**REQUEST TO WITHDRAW NOTICE OF
ABANDONMENT UNDER 37 C.F.R. 1.8(b)**

Special Processing and Correspondence Branch
ONAR, Application Processing Division
Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

It is respectfully requested that the notice of abandonment issued in the above captioned application be withdrawn. The circumstances are as follows:

1. On July 10, 1997, the undersigned received a notice of abandonment mailed July 8, 1997, a copy of said notice being attached hereto and marked Exhibit 1.

2. Exhibit 1 states that the application was abandoned in view of applicant's alleged failure to respond to the Office letter, mailed December 9, 1996.

3. However, applicant did indeed respond to said Office letter. Applicant submitted a Request for Filing a Continuation Application Under Rule 37 C.F.R. §1.62, which included a Petition for a three month extension, a copy of which is attached hereto and marked Exhibit 2. The Request included an Express Mail Certificate of Mailing signed by the undersigned and dated June 9, 1997.

4. Accompanying the Amendment was check No. 7736 in the amount of \$1,700.00 for payment of a three month extension of time of \$930.00 and the filing fee of \$770.00, along with a receipt acknowledgment postcard (Exhibit 3).

5. These documents were addressed to Box: FWC, Commissioner of Patents and Trademarks, Washington, D.C., 20231, and were deposited with the U.S. Postal Service with sufficient postage as Express Mail on June 9, 1997, which met the deadline of June 9, 1997.

6. Upon receipt of Exhibit 1, the undersigned checked his files and secured the receipt acknowledgment postcard which had been *stamped by the Mail Room and returned by the PTO*, a copy of the postcard being attached hereto and marked Exhibit 3. The check for \$1,700.00 has not yet cleared the undersigned's bank account. Presumably, all



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

PAPER FILED
FEB 13 1998
Paper No. 18

Kirschstein, Ottinger, Israel &
Schiffmiller, P.C.
551 Fifth Avenue
New York, NY 10176-0024

Mailed

FEB 10 1998

Director's Office
Group 2700

In re Application of
Mark T. Jeffrey, et al.)
Application No. 08/400,140) DECISION ON PETITION TO
Filed: March 6, 1995) WITHDRAW HOLDING OF
For: STM SWITCHING ARRANGEMENT) ABANDONMENT)

This is a decision on the petition, filed July 17, 1997, to withdraw the holding of abandonment of the above-identified application.

This application was held abandoned for failure to respond in a timely manner to the final rejection of December 9, 1996. A Notice of Abandonment was mailed on July 8, 1997.

Petitioner states that a response was in fact timely filed. To support this assertion, petitioner has submitted a copy of a return postcard which acknowledges receipt of a request for filing a continuation under 37 CFR § 1.62, a petition for an extension of time of (3) three months and a check for \$1,700.00 by the Patent and Trademark Office on June 10, 1997. The request included an Express Mail Certificate of Mailing dated June 9, 1997.

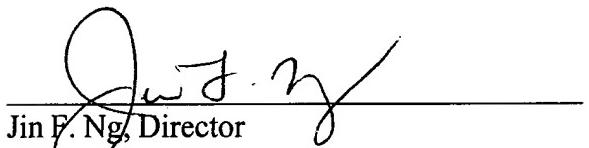
The original response was not associated with the application file at the time the Notice of Abandonment was mailed but has since been matched therewith.

The filing of a request under 37 CFR § 1.62 is considered an express request to abandon the parent application as of the filing date granted the continuing application. See 37 CFR § 1.62(g).

In view of the above stated reasons, the effective date of abandonment is changed to fall on the filing date granted in the continuing application.

The petition is **GRANTED** to the extent indicated.

The request under 37 CFR § 1.62 is being forwarded to Application Branch for processing.



Jin F. Ng, Director

Technology Center 2700-
Communications and Information Processing

571 272 7400

2600

RWML 571 272 4550

**Change Of Attorney Or Agent's Address In Application
(37 CFR 1.8(a))**

Docket No.

In Re Application Of: **JEFFREY**

PARENT

CHILD

Serial No.

08/400,140

08/872,078

Filing Date

03/06/95

06/10/97

Examiner

KIZOU

LUTHER

Group Art Unit

2603

2731

Invention: **STM SWITCHING ARRANGEMENT**

TO THE ASSISTANT COMMISSIONER FOR PATENTS

Please send all correspondence for this application to:

ALAN ISRAEL, ESQ.

REGISTRATION NO. 27,564

KIRSCHSTEIN, OTTINGER, ISRAEL & SCHIFFMILLER, P.C.

489 FIFTH AVENUE

NEW YORK, NEW YORK 10017-6105

Please direct all telephone calls to:

TEL: (212) 697-3750

FAX: (212) 949-1690

Signature of Attorney or Agent of Record

**Alan ISRAEL, Esq., Registration No. 27,564
KIRSCHSTEIN, OTTINGER, ISRAEL
& SCHIFFMILLER, P.C.
551 Fifth Avenue
New York, New York 10176**

Registration Number & Address of Attorney or Agent of Record

Dated: MAY 20, 1998

I certify that this document is being deposited on
May 20, 1998 with the U.S. Postal Service as
first class mail under 37 C.F.R. 1.8 and is addressed to the
Assistant Commissioner for Patents, Washington, D.C.
20231.

Signature of Person Mailing Correspondence

Alan Israel

Typed or Printed Name of Person Mailing Correspondence



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/400,140	03/06/95	JEFFREY	M GPT/4265-US

KIRSCHSTEIN OTTINGER
ISRAEL & SCHIFFMILLER
551 FIFTH AVENUE
NEW YORK NY 10176-0024

LM11/1209

EXAMINER	
LUTHER, W	
ART UNIT	PAPER NUMBER
2731	
DATE MAILED:	12/09/95

NOTICE OF ABANDONMENT

This application is abandoned in view of:

1. Applicant's failure to respond to the Office letter, mailed _____.
2. Applicant's letter of express abandonment which is in compliance with 37 C.F.R. 1.138.
3. Applicant's failure to timely file the response received _____ within the period set in the Office letter.
4. Applicant's failure to pay the required issue fee within the statutory period of 3 months from the mailing date of _____ of the Notice of Allowance.
 The issue fee was received on _____.
 The issue fee has not been received in Allowed Files Branch as of _____.
- In accordance with 35 U.S.C. 151, and under the provisions of 37 C.F.R. 1.316(b), applicant(s) may petition the Commissioner to accept the delayed payment of the issue fee if the delay in payment was unavoidable. The petition must be accompanied by the issue fee, unless it has been previously submitted, in the amount specified by 37 C.F.R. 1.17 (l), and a verified showing as to the causes of the delay.
- If applicant(s) never received the Notice of Allowance, a petition for a new Notice of Allowance and withdrawal of the holding of abandonment may be appropriate in view of Delgar Inc. v. Schuyler, 172 U.S.P.Q. 513.
5. Applicant's failure to timely correct the drawings and/or submit new or substitute formal drawings by _____ as required in the last Office action.
 The corrected and/or substitute drawings were received on _____.
6. The reason(s) below.

The application 08/400,140 is effectively abandoned
June 18, 1995

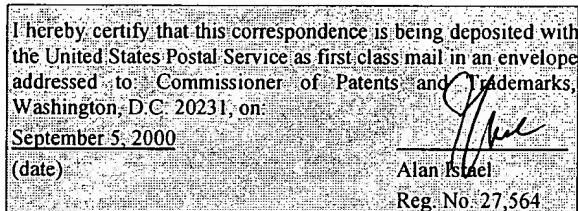
William Luther
(703) 308-6629

DISCRETE/151

DEC 14 1995

U.S. SCHIFFMILLER INC.

**PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**



In re: Application of : Mark T. JEFFREY, et al.
Serial No. : 08/872,078 Group Art Unit: 2731
Filed : June 10, 1997 Examiner: W. Luther
For : STM SWITCHING ARRANGEMENT

New York, New York
September 5, 2000

COMMUNICATION

Hon. Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Prior to examination, consideration and entry of the following remarks are requested.

Regarding the Examiner's rejection under 35 U.S.C. §103 in the parent application, the Examiner relies on the combination of Takeuchi and Beshai. However, it is not apparent how such a combination could result in an arrangement which offered the attributes claimed by the Examiner. In the opinion of the applicants, such a combination would not be practical and *would not work*.

Turning to Beshai, the central element of the switch (18) comprises a set of packet buffers. These are connected to inputs and outputs via sets of input and output FIFO's (14, 16). Distribution of incoming packets among the various packet buffers is achieved by means of the input rotator. In introducing the concept of the rotator, Beshai states (col. 4, lines 3-7) that, due to the nature of the operation of the switch, both the outlet and the input "must rotate".

In contrast, in the system of Takeuchi, distribution of incoming packets is achieved by means of the bus 215. It is evident that rotators are *not necessary* for correct operation of the arrangement of Takeuchi.

The applicants would like to point out that these two methods of distribution -- rotator and bus -- are mutually incompatible and inclusion of both types of distribution in one system is contrary to common sense. If, for instance, it is proposed to include a rotator from Beshai at the input to the unit switches of Takeuchi (#1 - # P) any distribution thereby achieved would be changed by redistribution via the bus. If, as in Beshai, the rotator is able to achieve the desired distribution, then the bus of Takeuchi would appear to be redundant.

Following this line further: the rotator in Beshai would require addition of FIFO buffers at the inputs. If rotators were to be added to the outputs, then a similar argument applies and further FIFO buffers should be added here as well. In the resulting system therefore, the bus 215 and the FIFO buffers 2171 of the unit switches of Takeuchi would no longer be necessary. However, removing these features would arrive at a system substantially identical to that disclosed by Beshai, as distinct from any proposed combination of Beshai with Takeuchi. In fact, the characteristic features of Takeuchi are no longer present.

The applicants therefore respectfully disagree with the Examiner when he states that it would have been obvious to one of ordinary skill to adapt the ATM switch of Takeuchi in the light of Beshai. As shown above, such a combination is not practical.

Applicants also point out that, contrary to the statement by the Examiner, no suggestion can be found in Beshai to adapt the ATM switch of Takeuchi to STM switching.

Applicants respectfully maintain their argument, originally put forward in the Preliminary Amendment of March 6, 1995, that it is not possible to include rotators in Takeuchi by any simple means and any such suggestion by the Examiner has no foundation. Even if it were possible to include rotators in Takeuchi, this would *not* convert into an STM switch. There is *no* indication of how to carry out such a conversion. Indeed, this conversion does not appear possible.

The Examiner suggests that the ATM switch of Takeuchi can be converted into an STM switch on the basis of a reference to a hybrid STM/ATM switch in Beshai and that the rotor of Beshai can be added to the converted switch of Takeuchi, whereas there is no teaching in either Takeuchi or Beshai that the above can or should be carried out. Applicants restate their opinion that the Examiner appears to be attempting to conclude that the cited references anticipate or make obvious the combination of elements of the claims by the use of hindsight. The Examiner employs a quotation from case law implying that hindsight may be allowable so long it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure. However, from the Examiner's argumentation, it is clear that the *only* indication to combine Takeuchi with Beshai is found in the arrangement of the present invention, and that the Examiner is using knowledge which was *not* available to the skilled person at the time the invention was made.

The Examiner is referred once again to the case law outlined in the Preliminary Amendment of March 6, 1995. This case law showing that the mere fact that a reference cited by an Examiner may be modified does not allow an Examiner to meet his burden for showing obviousness absent a suggestion in the cited art of the desirability of the modification. None of the cited references makes such a suggestion relative to the claims now presented. Moreover, it has been held that an Examiner "may not use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious".

Reconsideration and withdrawal of the outstanding rejection are respectfully requested.

Respectfully submitted,

KIRSCHSTEIN, OTTINGER, ISRAEL & SCHIFFMILLER, P.C.
Attorneys for Applicant(s)
489 Fifth Avenue
New York, New York 10017-6105
Tel: (212) 697-3750
Fax: (212) 949-1690



Alan Israel
Registration No. 27,564

Jeffrey - 08/872, o-78

Called PTO - Left message 9/18/98
" " " " 7-15-99
Called Luther - No response 9/1/00
" 898 - No 6/6/00

tried again - No response 4/8/02
Called left word 11/6/02

(Can't reach him - Left message) 8-4-03

Feb 9/04 - Left message - no response

5/6/05 - again - Can't reach anyone

Try Ex'ra NG 2/13/06 he's not responding either

12/12/07 Not there anymore.

Ext. Powell) - 2600 → Patel -

Pezzillo will handle -